

**REMARKS**

Claim 1 has been amended to require that the immunocompromised transgenic rodent is further modified to contain a tumor that expresses a second fluorescent protein that emits a wavelength different from that emitted by the fluorescent protein that is constitutively expressed in all cells. Support for this amendment is found, for example, in paragraphs 29-31 of the application as well as in Example 3. No new matter has been added. Entry of the amendment, though made after final, is respectfully requested as it clearly distinguishes the cited documents.

The sole outstanding basis for rejection is for obviousness over Kern (WO02/28188) in view of Okabe, *FEBS Lett* (1997) 467:313-319.

Applicants believe that the amendment to claim 1 clearly distinguishes Kern in combination with Okabe for the following reasons. Kern is directed to a method to purify tumor cells by creating immunodeficient recipient hosts that are transgenic for selectable markers. The immunodeficiency of the rodents permits the tumors to be grown in them, and a selectable marker in the transgenic host permits the host cells to be eliminated from cultures of the transplanted tumors so that only the tumor cells will remain. In the more rational embodiments of Kern's invention, the host cells have truly selectable markers wherein the culture will automatically eliminate the host cells by virtue of their inability to survive. However, in one of the more laborious approaches, the host cells may be simply labeled so that they can be recognized and mechanically separated.

Leaving aside the impracticality of this embodiment, it is clearly inadequate to suggest the claims as currently amended. Indeed, it would defeat the purpose of Kern to provide tumor cells that are themselves labeled with a fluorescent protein, since this label itself could be used to distinguish the tumor cells from those of the host.

Based on Kern in combination with Okabe, no motivation is found to supply labeled tumors to the immunodeficient host.

Applicants have not walked away from their argument that success in obtaining stably transformed immunodeficient mice expressing fluorescent protein in every cell is a surprising result that has not been achieved by Kern, who simply describes how one might go about achieving the result, without demonstrating that what appears to be an impossibility can really be achieved. However, in order to provide a clear distinction, the current amendment is offered.

Reconsideration, entry of the amendment, and passage claims 1-3 as amended, to issue is respectfully requested.

Should minor issues remain that could be resolved over the phone, a telephone call to the undersigned is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 312762004400.

Respectfully submitted,

Dated: September 4, 2009

By: : \_\_\_\_\_ / Kate H. Murashige /  
Kate H. Murashige  
Registration No.: 29,959  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
Telephone: (858) 720-5112